Supreme Court, U. S.
FILED
MAY 13 1980
MICHAEL RODAK, JR., CLERK

No. 79-1692

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1979

**FAMOLARE, INC.,**

*Petitioner,*

v.

**EDISON BROTHERS STORES, INC. and USM CORP.,**

*Respondents.*

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit**

## RESPONDENTS' BRIEF IN OPPOSITION

RAYMOND P. NIRO
WILLIAM L. NIRO
LOUIS ALTMAN
HOSIER, NIRO & DALEIDEN, LTD.
135 South LaSalle Street
Chicago, Illinois 60603
(312) 236-0733
*Attorneys for Respondents*

*Of Counsel:*
RICHARD B. MEGLEY
181 Elliott Street
Beverly, Mass. 01915

Midwest Law Printing Co., Chicago 60601, Financial 6-3988

## TABLE OF CONTENTS


| | PAGE |
|---|---|
| REASONS FOR DENYING THE WRIT | 2 |
| The Decisions Below Are Consistent With The Legal Standards Applied By This Court | 3 |
| No Conflict Exists Between The Circuits | 6 |
| The Issue Presented By Petitioner Is Not Important Enough To Warrant Review By This Court | 8 |
| CONCLUSION | 10 |
| APPENDIX: | |
| Court of Appeals Order of February 29, 1980 | R1 |
| Court of Appeals Order of March 18, 1980 | R2 |


## TABLE OF AUTHORITIES

*Cases*


| | |
|---|---|
| *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) | 3, 4, 7 |
| *Dann* v. *Johnston*, 425 U.S. 219 (1976) | 4, 7 |
| *Frantz Manufacturing Co.* v. *Phenix Manufacturing Co.*, 457 F.2d 314 (7th Cir. 1972) | 3 |
| *G. B. Lewis Company* v. *Gould Products, Inc.*, 436 F.2d 1176 (2nd Cir. 1971) | 7 |
| *Gorham Mfg. Co.* v. *White*, 81 U.S. 551 (1872) | 5, 6 |
| *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) | 2, 6, 7 |
| *Moore* v. *C. R. Anthony Co.*, 198 F.2d 607 (10th Cir. 1952) | 8 |

*Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273 (1976) ..... 4, 7

*S. Dresner & Son, Inc.* v. *Doppelt*, 120 F.2d 50 (7th Cir. 1941) ..... 6

*Smith* v. *Whitman Saddle Co.*, 148 U.S. 674 (1893) ..... 3, 4, 6, 8

*In re Stirling*, 47 F.2d 809 (C.C.P.A. 1931) ..... 6

*Thabet Mfg. Co.* v. *Kool Vent Metal Awning Corp.*, 226 F.2d 207 (6th Cir. 1955) ..... 7, 8

*Constitution and Federal Statutes*

U.S. Constitution, Article I, Section 8 ..... 2

28 U.S.C. §1254(1) ..... 1

35 U.S.C. §103 ..... 5

35 U.S.C. §171 ..... 9

CITATIONS IN THIS BRIEF

The citations in this brief are to the text of the petition for writ of certiorari (P. .....), to the petitioner's appendix integrally bound therewith (A. .....), or to respondent's appendix bound herewith (R. .....).

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1979

---

**FAMOLARE, INC.,**

*Petitioner,*

**v.**

**EDISON BROTHERS STORES, INC. and USM CORP.,**

*Respondents.*

---

**On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit**

---

## RESPONDENTS' BRIEF IN OPPOSITION

---

Respondents, Edison and USM, agree that this Court has jurisdiction to consider Famolare's petition for writ of certiorari under 28 U.S.C. § 1254(1). The petition, however, presents no question meriting this Court's review.

This case involves no novel or disputed questions of law. Invalidity of both Famolare patents was established by the facts as found by the District Court. The decision of the District Court, after consideration of the record, was unanimously affirmed *per curiam* by the Court of Appeals. A petition for rehearing *en banc* was denied (R.

1). And, a motion to permit publication of the Court's unpublished order was denied on the ground, among others, that the case presented "no novel patent law questions and was decided in accordance with settled principles." (R. 2-3).

Moreover, the legal standard applied by both the District Court and the Court of Appeals is neither new nor controversial. It is the standard expressed in the Constitution and uniformly applied by this Court—patents cannot be granted for those things that neither add to the sum of useful knowledge nor advance the useful arts.

The petition for writ of certiorari should be denied.

## REASONS FOR DENYING THE WRIT

The purpose of the patent system is not to provide certificates of merit for promotional achievement. Its purpose is to advance the arts and sciences by inducing inventors to disclose meaningful artistic or utilitarian achievements that will benefit the public.

As this Court observed in *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966):

> "Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored." (Emphasis in original)

Article I, Section 8 of the Constitution, therefore, sets the threshold standard for the grant of a patent. And



patents—whether directed to utility or design—cannot be granted where the effect of such a grant is "to remove existent knowledge from the public domain or to restrict free access to materials already available." *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969).

## THE DECISIONS BELOW ARE CONSISTENT WITH THE LEGAL STANDARDS APPLIED BY THIS COURT

Petitioner suggests that the law of design patents is in "total disarray" because this Court has not considered a design patent case since 1893. (P. 5). In truth, there has been no need for this Court's review. The last design patent case decided by this Court settled the matter. *Smith v. Whitman Saddle Co.*, 148 U.S. 674 (1893). There the Court (quoting Mr. Justice Brown) found that the same standard existed for both design and mechanical patents,[1] and that:

> "To entitle a party to the benefit of the Act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however

[1] 148 U.S. at 679. More recently Mr. Justice Stevens (then Judge for the Court of Appeals for the Seventh Circuit) observed in *Frantz Manufacturing Co. v. Phenix Manufacturing Co.*, 457 F.2d 314, 327 (7th Cir. 1972):

> ". . . a patented design, like the subject matter of a mechanical patent, must embody invention. The purpose of the statute is to reward, and thereby to encourage, creative artistic activity rather than mere changes of detail which may produce 'novelty' but do not reflect 'invention'. The inventor must make a 'contribution to the public which the law deems worthy of recompense.' "

convenient, useful, or beautiful they may be in their new role, is not invention."

The District Court and the Court of Appeals not only used the proper standard of invention, as applied to the facts of this case, but they also properly interpreted the standard in view of the constitutional limitations that define the threshold conditions for patentability. The District Court concluded, after considering all of the relevant facts, that:

> "The design patent is invalid in that it lacks invention over the prior art and reflects no creative originality or artistry." (A. 32).[2]
>
> * * *
>
> ". . . it [the patented design] does not represent such an inventive contribution to the public or such a meaningful advance in the shoe design art that it constitutes invention." (A. 40).

The Court of Appeals affirmed the correctness of that conclusion:

> "There is, meanwhile, no question that the issue of invention, properly understood (as it was below), remains relevant to consideration of patent validity." (A. 8-9).

---

[2] Petitioner conceded below that "the standard of validity of both design and utility patents is invention and that invention in design is measured by whether the design is new, original, ornamental and non-obvious." (A. 36). Every decision of this Court since *Graham* has confirmed that "invention" is still the ultimate constitutional and statutory test of patentability. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 at 61 (1969) (". . . those matters without invention will not make patentability."); *Dann v. Johnston*, 425 U.S. 219 at 225 (1976) ("As a judicial test, 'invention'—*i.e.*, 'an exercise of the inventive faculty, . . . has long been regarded as an absolute prerequisite to patentability.'"); *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 at 279 (1976) ("It has long been clear that the Constitution requires that there be some 'invention' to be entitled to patent protection.").



Petitioner's patents simply did not measure up to the exacting standard of invention the law requires. Hence, they were held invalid.

Lack of invention, however, was not the only basis for invalidity. Petitioner's design patent was also held invalid on the ground that the patented design "would have been obvious to a designer of ordinary skill" in the art. (A. 32). That further standard of patentability, as codified in 35 U.S.C. § 103, was likewise not met by Petitioner's design.[3]

The District Court's meticulous consideration of both the overall aesthetic effect of Petitioner's shoe sole design—the *tout ensemble*—and the individual design elements that make up the whole is evident from the record. (A. 9). The evidence before the District Court not only demonstrated that all of the essential features of the patented sole design were old, it conclusively established that the combination itself, while slightly different than previously achieved, was still "within the skill of an ordinary designer having the prior art before him." (A. 38).

*Gorham Mfg. Co. v. White*, 81 U.S. 511 (1872) does not mandate any different analysis of the obviousness issue. Indeed, as various courts have observed, the question of

---

[3] Even a casual review of the prior art shoe soles illustrated in Petitioner's Appendix demonstrates why the legal conclusion of obviousness is inescapable. The scope Petitioner attributed to its design patent (which by law sets the bounds for determining validity) included soles with three, four or five undulations, soles with or without side ornamentation, and even soles with sculptured sides and flat bottoms (A. 27, 34 and 36). When the scope attributed by Petitioner to its own patent is compared to the prior art soles, there is, in fact, no difference between the patented sole and the prior art, much less a non-obvious difference.

invention was not an issue in *Gorham* because the matter reached this Court with invention conceded. *In re Stirling*, 47 F.2d 809, 811 (C.C.P.A. 1931); *S. Dresner & Son, Inc. v. Doppelt*, 120 F.2d 50, 51-52 (7th Cir. 1941).

This Court's decision in *Whitman Saddle*, decided eleven years after *Gorham*, is the controlling authority on design patent validity. And *Whitman Saddle*, like the decisions of the courts below, requires something more than the mere rearrangement of old components to justify the grant of a valid design patent (148 U.S. at 679).[4]

Neither the District Court nor the Court of Appeals departed from the time-honored standards that this Court has repeatedly held to be appropriate for determining design patent validity. There simply is nothing here to merit the Court's review.

## NO CONFLICT EXISTS BETWEEN THE CIRCUITS

Petitioner asserts that a confict exists among Circuit Courts on the significance of commercial success and copying in deciding the issue of patentability for designs. (P. 15-16). This Court held in *Graham* that matters such as commercial success are at best secondary considerations of patentability that may have

[4] Literal application of Petitioner's *tout ensemble* rationale to the issue of design patent validity would eliminate the statutory requirement of non-obviousness entirely. Under *Graham*, an analysis of the obviousness issue requires a factual determination of the differences between the claimed invention and the prior art (383 U.S. at 17). Absent an objective analysis of the component parts of a design that make up its whole, there would be no means of determining what, if any, differences exist between the prior art and the patented design.



relevance in some cases (383 U.S. at 17-18). But every decision of this Court since *Graham* has made it clear that commercial success and other secondary factors "without invention will not make patentability." *Anderson's-Black Rock*, 396 U.S. at 61; *Dann*, 425 U.S. at 230, n.4; *Sakraida*, 425 U.S. at 282-83.

Here, both the District Court and the Court of Appeals considered Petitioner's evidence of commercial success and copying and found it unpersuasive on the ultimate issue of validity. Why? Because Petitioner's design lacked invention and was obvious in view of the prior art.[5] No decision of this Court or any Circuit Court requires more.

Moreover, there appears to be uniformity, not conflict, among the circuits in applying the strict constitutional and statutory standards of patentability for design patents. The Second Circuit has insisted that the design reflect "some exceptional talent beyond the skill of the ordinary designer," and candidly recognizes that "to obtain a valid design patent is exceedingly difficult." *G. B. Lewis Company v. Gould Products, Inc.*, 436 F.2d 1176, 1178 (2nd Cir. 1971). The Sixth Circuit requires that a new design must "represent a step which has required inventive genius beyond the prior art." *Thabet Mfg. Co. v. Kool Vent Metal*

[5] The evidence before the District Court conclusively demonstrated that shoes become popular and successful for a myriad of reasons—fashion, timing, upper design, color, fit, fabric, comfort, price, advertising and promotion. (A. 24-25). Since Petitioner presented no evidence that would show that the success of its shoes was attributable to the aesthetic appeal of its shoe sole design, rather than the extraneous factors, the District Court and the Court of Appeals found that success or failure of a particular shoe style did not serve as an accurate barometer of the merit or lack of merit of a particular design. (A. 10, 11, 24-25).

*Awning Corp.*, 226 F.2d 207, 212 (6th Cir. 1955). The Tenth Circuit requires that a patented design "must not only be new and pleasing enough to win acceptance in the market place, it must also distinctly add to the total knowledge of the particular field of design . . . ." *Moore v. C. R. Anthony Co.*, 198 F.2d 607, 609 (10th Cir. 1952).

It is true, of course, that the history of design patents that reach the Courts of Appeal is replete with examples of designs that did not meet the required constitutional and statutory standards of patentability. That does not mean, however, that the established standards are either incorrect or should be discarded.[6]

## THE ISSUE PRESENTED BY PETITIONER IS NOT IMPORTANT ENOUGH TO WARRANT REVIEW BY THIS COURT

Petitioner also suggests that this Court should grant certiorari in a design patent case every so often just as a matter of general principle—implying that the design patent law is not working as the Constitution requires and the Congress intended. (P. 5).

Respondents believe that the absence of any decisions by this Court in the design patent area since *Whitman Saddle* evidences the fact that the patent law is

[6] The statistics contained in footnote 10 of the Petition hardly establish the proposition that the Seventh Circuit is a uniquely dangerous forum for design patents (P. 7). Petitioner's figures show that only the Third Circuit has found more than one design patent valid since 1948, while the Second, Fourth, Fifth, Sixth, Ninth and Tenth Circuits have each found only one design patent valid. The First, Seventh, Eighth and D.C. Circuits have found none valid since 1948. These statistics suggest neither a meaningful difference in approach between the Circuits, nor a departure from the established standards.



functioning exactly as Congress intended and the Constitution requires. Those designs that meet the constitutional and statutory standard are found valid. Those that do not are found invalid. Changing the standard, as Petitioner suggests, by eliminating the statutory requirements of originality[7] and non-obviousness, or by ignoring the constitutional prerequisites of innovation, advancement and public benefit, is certainly not justified by the facts in this case.

This is a routine patent case that was decided on its facts, with no novel or important points of law at issue. This case does not merit this Court's review, and the petition for writ of certiorari should be denied.

[7] Petitioner is critical of the use of the term "creative originality in artistry." (P. 10-12). "Originality", however, like novelty, ornamentality and non-obviousness, is an express statutory requirement for the grant of a design patent. 35 U.S.C. § 171.

## CONCLUSION

For the reasons stated above, Respondents respectfully request that the petition for writ of certiorari be denied.

Respectfully submitted,

RAYMOND P. NIRO
WILLIAM L. NIRO
LOUIS ALTMAN
HOSIER, NIRO & DALEIDEN, LTD.
135 South LaSalle Street
Chicago, Illinois 60603
(312) 236-0733
*Attorneys for Respondents*

*Of Counsel:*
RICHARD B. MEGLEY
181 Elliott Street
Beverly, Mass. 01915

May 12, 1980

# APPENDIX

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

February 29, 1980.

Before

Hon. THOMAS E. FAIRCHILD, *Chief Judge*
Hon. WALTER J. CUMMINGS, *Circuit Judge*
Hon. PHILIP W. TONE, *Circuit Judge*

---

FAMOLARE, INC.,

*Plaintiff-Appellant,*

No. 79-1451 vs.

EDISON BROTHERS STORES, INC. and
USM CORPORATION,

*Defendants-Appellees.*

---

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
No. 75C 2708—HUBERT L. WILL, *Judge.*

---

ORDER

On consideration of the petition for rehearing and suggestion for rehearing *en banc* filed in the above-entitled cause by plaintiff Famolare, Inc., no judge in active service has requested a vote thereon, and all of the judges on the original panel have voted to deny a rehearing. Accordingly,

IT IS ORDERED that the aforesaid petition for rehearing be, and the same is hereby, DENIED.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604

March 18, 1980.

Before

Hon. WALTER J. CUMMINGS, *Circuit Judge*
Hon. PHILIP W. TONE, *Circuit Judge*
Hon. .....

---

FAMOLARE, INC.,

*Plaintiff-Appellant,*

No. 79-1451 vs.

EDISON BROTHERS STORES, INC. and
USM CORPORATION,

*Defendants-Appellees.*

---

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
No. 75-C-2708—Judge HUBERT L. WILL.

---

This matter comes before the court for its consideration upon the following documents:

1. The "APPELLANT'S MOTION UNDER CIRCUIT RULE 17 FOR STAY OF MANDATE" filed herein on March 4, 1980 by counsel for the plaintiff-appellant.

2. The "MOTION TO PERMIT PUBLICATION OF UNPUBLISHED ORDER" filed herein on March 3, 1980 by counsel for the defendants-appellees.

3. The "RESPONSE TO APPELLEES' MOTION TO PERMIT PUBLICATION OF UNPUBLISHED



ORDER" filed herein on March 12, 1980 by counsel for the plaintiff-appellant.

This case presents no novel patent law questions and was decided in accordance with settled principles. Accordingly,

IT IS ORDERED that the motion for stay of mandate is hereby DENIED.

IT IS FURTHER ORDERED that the motion to permit publication of the unpublished order of this court is hereby DENIED.

---